

**Remarks**

Claim 3 has been canceled. Claim 1 has been amended simply to incorporate all of the features of canceled claim 3. Accordingly, Applicant submits that no new matter has been introduced by the amendment to claim 1. After entry of this amendment, claims 1, 2, 4 and 5 will be pending.

**1. Allowable Subject Matter**

Claim 3 is objected to as being dependent upon a rejected base claim but would be allowable, according to the Examiner, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

To expedite prosecution of the subject application, Applicant has canceled claim 3 and amended claim 1, from which claim 3 depended, to incorporate all of the features of claim 3. Accordingly, claim 1, as amended, should be in condition for allowance along with claims 2, 4 and 5, which each depend directly from claim 1.

**2. Rejection under 35 U.S.C. § 103(a)**

**A. Claim 1**

The Examiner has maintained his rejection of claim 1 as allegedly unpatentable over U.S. Patent 6,348,519 to Ohshima *et al.* ("Ohshima"). The Examiner asserts that Ohshima teaches each of Applicant's claimed features except for the total solids content of the resin particles being in the range of from about 20 to about 80% by weight. According to the Examiner, it would have been obvious to a person of ordinary skill in the art to discover the claimed range through optimization experiments requiring only routine skill.

Applicant respectfully disagrees with the Examiner's assessment of Ohshima as allegedly rendering obvious Applicant's claim 1. The Examiner asserts that Ohshima teaches Applicant's claimed feature of the content of the photo-curable resin relative to the total weight of the non-photo-curable resin and the photo-curable resin as being from about 10 to about 80%. The Examiner specifically cites to column 5, lines 56-60 of Ohshima as evidence of this teaching, stating that this section teaches 30% of a photo-curable resin A and 40% of a non-photo-curable resin B. From this alleged disclosure, the Examiner indicates that the content of resin A relative to the total weight of resins A + B is  $[B/(A+B)] * 100\% = [40/(30+40)] * 100\% = 57\%$ , which is between Applicant's claimed range of about 10 to about 80%.

In rebuttal, Applicant first notes that the Examiner's calculation would result in the content of resin B (not resin A) relative to the total weight of resins A + B. More significantly, however, is

Applicant's submission that resin A, which is an oligomer, and resin B, which is a monomer, are both examples of photo-curable resins. As such, Ohshima cannot render claim 1 obvious because there is no teaching or suggestion in Ohshima regarding the recitation in claim 1 of the range of the content of the photo-curable resin relative to the total weight of the non-photo-curable resin and the photo-curable resin being from about 10 to about 80%.

However, in an effort to expedite prosecution of the subject application, Applicant has amended claim 1 to incorporate the features of allowable claim 3. Accordingly, claim 1, as amended, should now be in condition for allowance. Applicant therefore respectfully requests that this rejection be withdrawn.

#### **B. Claim 2**

The Examiner maintains his rejection of claim 2 as allegedly unpatentable over Ohshima in view of U.S. Patent 5,513,569 to Mathias ("Mathias"). The Examiner acknowledges that Ohshima does not disclose inkjet printing but cites Mathias as teaching that screen printing, which the Examiner asserts is taught by Ohshima, is equivalent to inkjet printing. Thus, according to the Examiner, it would have been obvious to a person of ordinary skill in the art to substitute screen printing for inkjet printing for the same purpose of printing an image.

Applicant respectfully disagrees with the Examiner's assessment of the teaching of the combination of Mathias with Ohshima to render Applicant's claimed invention obvious. However, in an effort to expedite prosecution of the subject application, Applicant has amended claim 1, from which claim 2 depends, to incorporate the features of allowable claim 3. Applicant therefore requests that this rejection be withdrawn.

#### **C. Claim 4**

Claim 4 is rejected as allegedly obvious over Ohshima in view of U.S. Patent 5,962,552 to Mikami *et al.* ("Mikami"). The Examiner acknowledges that Ohshima fails to teach at least one non-photo-curable resin that is acrylic silicone, but relies on Mikami for teaching this feature.

Applicant respectfully disagrees with the Examiner's assessment of the teaching of the combination of Mikami with Ohshima to render Applicant's claimed invention obvious. However, in an effort to expedite prosecution of the subject application, Applicant has amended claim 1, from which claim 4 depends, to incorporate the features of allowable claim 3. Applicant therefore requests that this rejection be withdrawn.

**D. Claim 5**

Claim 5 is rejected as allegedly obvious over Ohshima in view of U.S. Patent 6,086,197 to Kubota *et al.* ("Kubota"). The Examiner acknowledges that Ohshima fails to teach at a non-photo-curable resin that is a fluororesin, but relies on Kubota for teaching this feature.

Applicant respectfully disagrees with the Examiner's assessment of the teaching of the combination of Kubota with Ohshima to render Applicant's claimed invention obvious. However, in an effort to expedite prosecution of the subject application, Applicant has amended claim 1, from which claim 5 depends, to incorporate the features of allowable claim 3. Applicant therefore requests that this rejection be withdrawn.

**3. Conclusion**

Applicant believes that all grounds for rejection have been fully addressed and that the subject application is now in condition for allowance. Should the Examiner feel that there are any issues outstanding after consideration of this amendment, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully Submitted,

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